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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Appellant: Domel	)	Art Unit: 3634
	)	
Serial No.: 10/062,655	)	Examiner: Johnson
	)	
Filed: February 1, 2002	)	1006.023
	)	
For: OPERATING SIGNAL SYSTEM AND METHOD	)	February 14, 2008
FOR CONTROLLING A MOTORIZED WINDOW	)	750 B STREET, Suite 3120
COVERING	)	San Diego, CA 92101
	)	

REPLY BRIEF

Commissioner of Patents and Trademarks  
Washington, DC 20231

Dear Sir:

This Reply Brief responds to the Examiner's Answer dated February 11, 2008, now relying on principles enunciated in KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727 (2007) to avoid complying with the requirements of the MPEP discussed in Appellant's Appeal Brief regarding explaining why seemingly non-analogous art is analogous. KSR, however, did not obliterate the requirement that Section 103 art must be analogous.

Instead of complying with the requirements of the MPEP to show why the window covering artisan would have logically looked to Buccola's door locks or Germany's doors, the examiner cites a recognition of a problem *from the present specification* on page 4 of the Answer, lines 4-7 and then, on page 5 cites the following guidance from KSR:

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"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

"When considering obviousness of a combination of known elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions."

A few sentences later, however, the Court quite carefully clarified that:

"a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art", citing United States v. Adams, 383 U.S. 39, 40, (1966).

Accordingly, there are some important points that the Court made in the above-quoted portions of KSR that have been elided over. Without understanding the fact pattern of KSR, simply parroting parts of it and ignoring other parts does a disservice to the case.

In KSR, accelerator pedals such as the one at issue were known to experience problems with wire chafing (from the Rixon patent - *not* from the asserted Engelgau patent's own specification). The Court in KSR relied on *actual testimony of record in the case* from skilled artisans as to the level of knowledge in the art regarding the asserted references (Redding and Smith, which had been considered by the PTO, and Asano and Rixon, which had not). Analogousness was not an issue for any reference.

Nevertheless, in the last paragraph of the decision the Court unambiguously grounded its holding in *evidence of record* as opposed to the conjecture that characterizes the present rejections: "KSR provided

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*convincing evidence* that mounting a modular sensor on a fixed pivot point of the Asano pedal was a design step well within the grasp of a person of ordinary skill in the relevant art. Its arguments, *and the record*, demonstrate that claim 4 of the Engelgau patent is obvious" (emphasis mine).

Compare the developed record in KSR, replete with expert testimony, with the endemic speculation that permeates the rejections. No "design incentives" or "market forces" beyond the sentence that the examiner quotes from the present specification - which is not fair game - have been identified for adding a door lock idea to a window covering much less has this conjectural leap been supported by evidence of record, in marked contrast to the careful and meticulous grounding of KSR. While the KSR Court observed that "if a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability", the conditional "if" has not been addressed in this case by any evidence of record. Indeed, the record is devoid of any indication of cross-fertilization between the window covering art and the door lock art. Would "a person of ordinary skill in the art recognize that" the technique Buccola uses for door locks would improve "similar devices" in the same way? No, not on the record. Furthermore, there is nothing on the record to indicate that door locks are considered to be "similar" to window coverings much less that the skilled artisan would so recognize it. There is nothing other than examiner argumentation to show that the proposed improvement of adding Buccola's door lock idea to van Dinteren's window covering system is predictable.

Taken to what must be regarded as an unintended extreme, KSR would prevent patentability of any and all inventions that used old elements, which is to say, anything under the sun made by man. And indeed, the Court did not so intend, and said so: "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art", and this the Court was most careful not to do. Evidence is the innovator's safeguard and evidence is what the Court in KSR grounded

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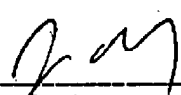
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its holding on. If proponents of obviousness were permitted to allege without evidence certain "design incentives and other market forces"; if patent examiners could make unsupported allegations about what are and are not "predictable variations"; if accused infringers could forever escape liability simply by speculating without evidentiary support that "a person of ordinary skill in the art would recognize [something] would improve similar devices in the same way", it may be time to close up shop on innovation in the U.S. and offshore it.

Much of the Appeal Brief remains unrebutted and thus conceded. For instance, the teaching away of Germany has not been addressed in the Answer, nor has Appellant's comments that claims 19 and 20 have not been mentioned in the rejections.

Respectfully submitted,

  
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